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OFFICE OF PETITIONS

In re Application of	:	
Koenig et al.	:	DECISION ON APPLICATION
Application No. 10/028,752	:	FOR
Filed: December 20, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. KCC 4742	:	
(14,442A)	:	

This is a decision on the "PETITION FOR APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)," filed February 2, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from thirty-three (33) days to two hundred twenty-six (226) days.

The application for patent term adjustment is **DISMISSED**.

On November 2, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 33 days. On February 2, 2006, applicants timely submitted the instant application for patent term adjustment¹. Applicants dispute the reduction pursuant to § 1.704(b) of 2 days, and the reduction pursuant to § 1.704(c)(8) of 43 days, 98 days, and 50 days.

Applicants state that the patent issuing from this application is subject to a terminal disclaimer.

¹ PALM records show that the Issue Fee was also received on February 2, 2006.

Applicants request the removal of the reduction of 2 days on the ground that the response to the Office action mailed July 2, 2004, was filed timely on October 4, 2004. Applicants assert that the three (3) month shortened statutory period for response to the Office action of July 2, 2004, fell on Saturday, October 2, 2004, and therefore, they had until the next succeeding business day, October 4, 2004, to file a timely response.

Applicants were properly assessed a delay of 2 days for filing a response on October 4, 2004, to the Office action of July 2, 2004. Calculation of applicants' delay is based on the date of receipt of the response in the Office. 35 U.S.C.

154(b)(2)(C)(ii) does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three (3) month period.

Therefore, the "carry-over" provisions of 35 U.S.C. 21(b) does not apply to the three (3) month period in 35 U.S.C.

154(b)(2)(C)(ii).

Applicants request the removal of the reduction of 43 days, 98 days, and 50 days for filing of Information Disclosure Statements (IDS) on October 30, 2003, January 10, 2005, and October 4, 2005, respectively, after a reply had been filed. Applicants assert that the IDS filed October 30, 2003, and January 10, 2005, were actually filed October 28, 2003, and January 6, 2005, respectively, as evidenced by the accompanying certificates of mailing. In this regard, applicants' attention is directed to 37 C.F.R. § 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, the reduction for filing of IDS after a reply had been filed was calculated using the correct dates, October 30, 2003, January 10, 2005, and October 4, 2005.

Applicants contend that the IDS filed October 30, 2003, January 10, 2005, and October 4, 2005, are not supplemental replies

under § 1.704(c)(8)², but rather, are preliminary papers under § 1.704(c)(6)³. Applicants state that none of the supplemental IDS at issue were submitted for purposes of supplementing an Office response. Applicants further state that the supplemental IDS were submitted merely to report references for which applicants had become aware in compliance with their duty to disclose under 37 C.F.R. §§ 1.97 and 1.98.

It is undisputed that after filing responses on September 17, 2003, October 4, 2004, and August 15, 2005, applicants filed the IDS. The record does not support a conclusion that the examiner expressly requested the IDS. A review of the IDS filed October 30, 2003, January 10, 2005, and October 4, 2005, reveals that they did not include a § 1.704(d) statement⁴. Specifically, the IDS filed October 30, 2003, was accompanied by the statement:

² 37 CFR § 1.704(c)(8) states:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

³ 37 CFR § 1.704(c)(6) states:

Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice of allowance; or

(ii) Four months[.]

⁴ Applicants are reminded that § 1.704(d) was revised, effective May 24, 2004, as follows:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8),

No item of information contained in this Statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing this document after making reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c) more than *three* (3) months prior to the filing of this Statement.

Emphasis added. However, the required statement states, in pertinent part, that:

Each item of information contained in the information disclosure statement was cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than *thirty* days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Emphasis added.

The statements in the IDS filed January 10, 2005, and October 4, 2005, state that:

In accordance with 37 C.F.R. 1.97 and 1.98 and MPEP 609, and in compliance with the duty of disclosure set forth in 37 C.F.R. 1.56, applicants submit the attached PTO/SB/08A for consideration by the Patent and Trademark Office in the above-entitled application and to be made of record therein.

The statements in the IDS filed October 30, 2003, January 10, 2005, and October 4, 2005, are not tantamount to a statement that the communication was not received by any individual

(c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

This revision requires that the statement include the language "each item of information contained in the information disclosure statement was first cited ..." for the exception to apply. See 69 FR 21704, Apr. 22, 2004.

designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. Accordingly, it is concluded that the periods of reduction of 43 days, 98 days, and 50 days pursuant to § 1.704(c)(8) (not § 1.704(c)(6)) was properly entered for the filing of the IDS on October 30, 2003, January 10, 2005, and October 4, 2005, respectively.

The provisions of § 154(b), for adjustment due to examination delay, apply to original applications¹, other than designs, filed on or after May 29, 2000. The Office calculates patent term adjustment for examination delay in all eligible applications. In calculating the patent term adjustment, the Office does not differentiate between applications that have terminal disclaimers and those that do not. Nor does the Office undertake the burdensome task of reviewing every application with a terminal disclaimer to determine if the patent term adjustment accorded would adjust the term beyond the expiration date specified in the disclaimer.

Rather, on issuance of the application, in compliance with 35 U.S.C. 154(b) and 37 CFR § 1.703(g), it is indicated in the patent that the patent term adjustment indicated therein is subject to any disclaimer. Moreover, it is also stated therein that the patent is subject to a terminal disclaimer.

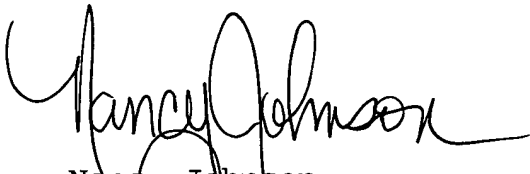
Lastly, applicants state that they filed a letter on January 25, 2006, after the mailing of the notice of allowance, in which they resubmitted the first and second supplemental IDS at the suggestion of the Office. Applicants assert that the submission of the letter of January 25, 2006, does not constitute a failure to engage in reasonable efforts to conclude processing or examination of the present application pursuant to § 1.704(c)(10). The Office reminds applicants that 37 C.F.R. § 1.705(d) provides for a revision of the patent term adjustment when revision is necessitated by events occurring after the mailing of the notice of allowance. Accordingly, applicants should raise this basis for seeking reconsideration of the patent term adjustment by filing a request for reconsideration under 37 C.F.R. § 1.705(d) with the required fee within TWO (2) MONTHS from the issue date of the patent.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance is 33 days.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized, flowing script.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions